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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/847,951	05/02/2001	Masaharu Hirooka	Y-181	6158

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DELLETT AND WALTERS  
310 S.W. FOURTH AVENUE  
SUITE 1101  
PORTLAND, OR 97204

EXAMINER

CHEUNG, MARY DA ZHI WANG

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 02/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/847,951

Applicant(s)

HIROOKA, MASA HARU

Examiner

Mary Cheung

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ML

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 September 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Status of the Claims***

1. This action is in response to the preliminary amendment filed on September 7, 2001. Claims 1-16 are pending. Claim 9 has been amended. Claims 10-16 have been added.

### ***Drawings***

2. The drawings are objected to because the word "INCOM" in item 38 of Figure 2 should be "INCOME". A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 9-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 9-16, the phrase "other measurements" renders the claims indefinite because the claims include elements not actually disclosed, thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-7 and 9-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barnard, U. S. Patent 6,456,938 in view of Germain, U. S. Patent 5,319,548.

As to claim 1, Barnard teaches a method of business in which GPS golf-course map data is collected and distributed, comprising (abstract):

- a) a step of registering GPS map data on a plurality of golf courses in a database connected to a network (column 17 lines 31-36 and column 36 lines 33-42),
- b) a step of accessing said database through said network, retrieving said GPS map data on a desired golf course among said plurality of golf courses, from said database, downloading and thereby offering said retrieved GPS map data to a user terminal device (column 17 lines 36-56 and column 36 lines 44-55).

Barnard does not specifically teach a step of preparing data for use in charging a user for use of said offered GPS map data. However, Germain teaches charging a user for use of golf information data (column 6 lines 62-64). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow Barnard's teaching to include the feature of charging a user for use of the GPS map data so that the GPS map data provider can be compensated for providing the data.

As to claim 2, Barnard teaches said GPS map data on said plurality of golf courses is uploaded to said database through said network (column 17 lines 31-36 and column 36 lines 33-42).

As to claim 3, Barnard teaches said network is internet or telephone lines (column 16 line 66 – column 17 line 3 and column 17 lines 31-56).

As to claim 4, Barnard teaches said user terminal device has a GPS function and a display device adapted to display said GPS map data and a current position of said user (column 6 lines 63-67 and column 16 line 51 – column 17 line 56 and Fig. 1).

As to claim 5, Barnard teaches said GPS map data stored in said database includes timer information, and said user terminal device has a timer function that works with said timer information (column 17 lines 62 – column 18 line 2 and column 21 lines 18-22).

As to claim 6, Barnard teaches said GPS map data stored in said database includes optional information (column 7 lines 59-60 and column 22 lines 24-28).

As to claim 7, Barnard teaches said optional information includes advisory information regarding an optimal approach to playing a hole of golf (column 29 lines 10-35).

As to claims 9-15, Barnard teaches said GPS map data is prepared by correcting map data obtained from satellite pictures by using data obtained from actual measurements of configurations of individual holes of a golf course, a distance to a cup, configuration of a green, position and configuration of a bunker, and other measurements (column 13 line 2 – column 14 line 18 and Fig. 3).

7. Claims 8 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barnard, U. S. Patent 6,456,938 in view of Germain, U. S. Patent 5,319,548 in further view of Rex, U. S. Patent 6,308,160.

As to claim 8, Barnard modified by Germain teaches providing GPS map data to a user and charging the user the usages of the GPS map data as discussed above. Barnard modified by Germain does not specifically teach attributes or golf-play records of said user or information on discounts to be provided to said user is registered in said database, and said optional information is selectively offered to said user terminal device based on said attributes or golf-play records of said user. However, this matter is taught by Rex as users are selectively offered discounts on the services that are provided (column 8 line 64 – column 9 line 7). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the user in the teaching of Barnard modified by Germain to include the feature of selectively offering users with discounts because this would promote certain users to more frequently use the GPS map data.

As to claim 16, Barnard teaches said GPS map data is prepared by correcting map data obtained from satellite pictures by using data obtained from actual measurements of configurations of individual holes of a golf course, a distance to a cup, configuration of a green, position and configuration of a bunker, and other measurements (column 13 line 2 – column 14 line 18 and Fig. 3).

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Bianco et al. (U. S. Patent 5,438,518) discloses a playing positioning and distance finding system.

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Jones (U. S. Patent 6,224,387) discloses producing pictorial tours from given amusement venues and then publishes those pictorial tours on the Internet.

Kuta et al. (U. S. Patent 6,582,328) discloses collecting golf game data.

Tsuda et al. (JP 05046079 A) discloses grasping the movement path of a golf cart on a golf course.

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***Inquire***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary Cheung whose telephone number is (703)-305-0084. The examiner can normally be reached on Monday – Thursday from 8:00 AM to 5:30 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell, can be reached on (703) 305-9768.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

The fax phone number for the organization where this application or proceedings is assigned are as follows:

(703) 872-9306      (Official Communications; including After Final  
Communications labeled "BOX AF")

(703) 746-5619      (Draft Communications)

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, 7<sup>th</sup> Floor Receptionist.

Mary Cheung  
Patent Examiner  
Art Unit 3621  
February 7, 2004

